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REMARKS/ARGUMENTS

Claims 26-48 are pending. Claims 26-46 were rejected under 35 U.S.C. § 103(a). Claims 47 and 48 were rejected under 35 U.S.C. § 102(e). Applicant proposes amending the independent claims to further clarify the invention. No new matter has been added.

Applicant thanks the Examiner for granting the Examiner's Interview of June 3, 2003 in which the Examiner indicated that U.S. Patent No. 5,842,185 (Chancey et al.) did not use a payee name that uniquely identifies a single payee.

Claim Rejections Under 35 U.S.C. § 102

Claims 47 and 48 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,842,185 (Chancey et al.). Applicants respectfully traverse the rejection under 35 U.S.C. § 102.

Applicants respectfully remind the Examiner that for prior art to anticipate a claim under §102 every element of the claimed invention must be identically disclosed either expressly or under principles of inherency in a single reference. Further, the exclusion of a claimed element from a prior art reference, no matter how insubstantial, is enough to negate anticipation by that reference. The test of whether anticipation exists in a particular case is a question of fact, and is applied element-by-element to a single prior art reference. Only if the prior art literally reads on every element of the rejected claim will the claimed invention be anticipated under this test. Similarly, the test for inherency is that it may only be relied upon where the consequence of following the cited reference always inherently produces or results in the claimed invention. However, if there does not exist a reasonable certainty that the claimed subject matter will result, or unintended, unappreciated and accidental results have occurred, then the cited reference will not anticipate the claimed invention by inherency.

During patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. During examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has provided a

clear definition in the specification. When not defined by applicant in the specification, the words of the claim must be given their plain meaning. In other words, they must be read as they would be interpreted by those of ordinary skill in the art. Applicant may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well-known usage.

Regarding independent claim 47, Chancey et al. does not recite using the received name of the transaction entry payee as the lookup name, wherein the received name of a transaction entry payee uniquely identifies a single payee. Chancey instead discloses a "merchant category code" (or "SIC") "that corresponds to a description of the payee's primary business or description of the type of transaction, such as service charge, credit, and the like, and is present in financial statements such as credit card statements." (Col. 4, line 64 – col. 5, line 4, emphasis added.) The SIC generally describes a payee's primary business (or type of transaction), and thus does not act to uniquely identify the transaction entry payee, which is a single payee. Thus, the SIC is not the received name of the transaction entry payee, and is not used as the lookup name.

Moreover, Chancey et al. does not suggest using the received name that uniquely identifies a single payee as the transaction entry payee. As described above, Chancey instead discloses a "merchant category code" (or "SIC") "that corresponds to a description of the payee's primary business or description of the type of transaction, such as service charge, credit, and the like, and is present in financial statements such as credit card statements." (Col. 4 line 64 – col. 5 line 4, emphasis added.) The description (or "category") is either suggested by the process or chosen from a list of recognized categories (which previously have been provided by the process, not the user). (Col. 5, lines 14-23.) Accordingly, using categories supplied by the system is helpful for tracking expense categories (*see*, abstract of Chancey), but not for uniquely identifying a single payee that is associated with the transaction. Using categories teaches away because using system-supplied generic codes will typically fail to uniquely identify any given single payee (which is an arbitrary entity). Using categories also teaches away because the description (which describes the payee's primary business or the type of transaction) is provided for the purpose of tracking expense categories, rather than uniquely identifying the single payee that is associated with the transaction.

For (at least) these reasons, it is respectfully submitted that the rejection to claim 47 under 35 U.S.C. 102(e) is traversed and claim 47 is proposed to be allowable. Claim 48 is proposed to be allowable for at least the reasons stated for claim 47.

Claim Rejections Under 35 U.S.C. § 103

Claims 26-28, 33-35, and 40-42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,842,185 (Chancey). Applicants respectfully traverse the rejection under 35 U.S.C. § 103.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A claimed invention is unpatentable as obvious under 35 U.S.C. § 103(a) if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. *Ruiz v. A.B. Chance Co.*, 57 USPQ2d 1161, 1165 (Fed. Cir. 2000). In making this determination, the Examiner must carefully avoid the "tempting but forbidden zone of hindsight" in which "that which only the inventor taught is used against its teacher." *In re Dembiczak*, 50 USPQ2d 1614, 1616-1617 (Fed. Cir. 1999). A prima facie case of obviousness based on a combination of references requires a "clear and particular" showing of a teaching or motivation to combine the references. *Winner International Royalty Corp. v. Wang*, 53 USPQ2d 1580, 1587 (Fed. Cir. 2000).

As amended, independent claims 26, 33, and 40 are similar to claim 47 (albeit different in other ways from claim 47) and are submitted to be patentable at least for the reasons given for claim 47. In particular, the prior art does not teach or suggest receiving a financial statement comprising one or more transaction entries, each transaction entry

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comprising a payee name and a transaction amount, wherein the payee name uniquely identifies a single payee. Claims 27-32 (which depend from independent claim 26), claims 34-39 (which depend from independent claim 33), and claims 41-46 (which depend from independent claim 40) should not be rejected under 35 U.S.C. § 103(a) for at least the reasons given for independent claims 26, 33, and 40, which are proposed to be allowable.

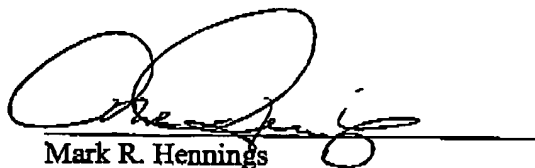
CONCLUSION

Applicants respectfully request favorable consideration for the allowance of claims 26-48. It is respectfully submitted that all claims in this case are patentable and that the application is in condition for allowance. Should any further aspects of the application remain unresolved, the Examiner is invited to telephone the Applicants' attorney at the number listed below. Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Attached hereto is a marked up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE**In the claims:**

Claims 26, 33, 40 and 47 have been amended as follows:

26. (Amended) A method for automatically renaming payee names received from the electronic transfer of financial data into a personal financial management program, comprising the steps of:

receiving a financial statement comprising one or more transaction entries, each transaction entry comprising a payee name and a transaction amount,
wherein the payee name uniquely identifies a single payee;

displaying a first transaction entry from the financial statement comprising a received payee name and an associated transaction amount;

receiving a user command replacing the received payee name with a preferred payee name;

creating a data structure including a record associating the received payee name with the corresponding preferred payee name;

automatically replacing the received payee name with the preferred payee name for each occurrence of the received payee name in the financial statement;

receiving a subsequent electronic financial statement comprising one or more transaction entries including the received payee name; and

automatically checking the data structure for the record associating the received payee name with the corresponding preferred payee name, retrieving the corresponding preferred payee name, and replacing the received payee name with the corresponding preferred payee name in each occurrence of the received payee name in the subsequent financial statement.

33. (Amended) A computer system configured to automatically rename payee names received from the electronic transfer of financial data into a personal financial management program by performing the steps of:

receiving a financial statement comprising one or more transaction entries, each transaction entry comprising a payee name and a transaction amount;

wherein the received name of a transaction entry payee uniquely identifies a single payee;

displaying a first transaction entry from the financial statement comprising a received payee name and an associated transaction amount;

receiving a user command replacing the received payee name with a preferred payee name;

creating a data structure including a record associating the received payee name with the corresponding preferred payee name;

automatically replacing the received payee name with the preferred payee name for each occurrence of the received payee name in the financial statement;

receiving a subsequent electronic financial statement comprising one or more transaction entries including the received payee name; and

automatically checking the data structure for the record associating the received payee name with the corresponding preferred payee name, retrieving the corresponding preferred payee name, and replacing the received payee name with the corresponding preferred payee name in each occurrence of the received payee name in the subsequent financial statement.

40. (Amended) A computer-readable medium on which is stored a computer program comprising instructions which, when executed by a computer, perform the steps of:

receiving a financial statement comprising one or more transaction entries, each transaction entry comprising a payee name and a transaction amount;
wherein the received name of a transaction entry payee uniquely identifies a single payee;

displaying a first transaction entry from the financial statement comprising a received payee name and an associated transaction amount;

receiving a user command replacing the received payee name with a preferred payee name;

creating a data structure including a record associating the received payee name with the corresponding preferred payee name;

automatically replacing the received payee name with the preferred payee name for each occurrence of the received payee name in the financial statement;
receiving a subsequent electronic financial statement comprising one or more transaction entries including the received payee name; and
automatically checking the data structure for the record associating the received payee name with the corresponding preferred payee name, retrieving the corresponding preferred payee name, and replacing the received payee name with the corresponding preferred payee name in each occurrence of the received payee name in the subsequent financial statement.

47. (Amended) A method for automatically renaming names of payees, wherein the names are received from the electronic transfer of financial data into a personal financial management program, comprising the steps of:

storing in a data structure preferred names that are each associated with a lookup name;

receiving a financial statement comprising one or more transaction entries, each transaction entry comprising a received name of a transaction entry payee and a transaction amount, wherein the received name of a transaction entry payee uniquely identifies a single payee;

for each transaction entry, using the received name of the transaction entry payee as the lookup name to determine whether the lookup name has an associated preferred name in the data structure, and if so, substituting the preferred name of the transaction entry payee for the received name of the transaction entry payee.